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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/988,181	12/10/97	OSHIMA	S Q48708
EXAMINER			

QM21/1218  
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ART UNIT	PAPER NUMBER
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3711

DATE MAILED:  
12/18/98

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on Nov. 5, 1998
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire -3- month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 6-9 + 12-43 is/are pending in the application.
- ☐ Of the above, claim(s) 6-9 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 12-43 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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Applicant is requested to provide for the record a copy of each reference cited in the parent case and not new cited by the examiner in the instant case, at which time the 1449 filed 12/10/97 will be completed.

More informative structural details at the point of novelty must be provided in the Abstract.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the diverse features now claimed, but not apparent to the eye from the drawings, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

For example the drawings do not show the indicia on the box "body", but rather only on the cover. If new matter is being claimed, this case must be labeled a CIP, not a continuation.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 6-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 6.

Claims 12-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Due to inconsistency in disclosed and claimed matter, it is not clear what features are critical, i.e., the claims define the indicia as being located on the box body, rather than the cover<sup>as</sup> illustrated on the drawings. Also, the number of claims (32) is excessive and confusing for the subject matter.

Claims 12-43 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-18 of prior U.S. Patent No. 5,713,803. This is a double patenting rejection.

The examiner fails to see wherein the instant claims 12-43 define a product that is not covered by the already patented claims 1-18.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 12-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,713,803. Although the conflicting claims are not identical, they are not patentably distinct from each other because the distinctions there over, if any, are minor ornamental design variants thereof that would be obvious to a person having ordinary skill in this art..

Claims 12-43 are rejected under 35 U.S.C. 102(a) as being anticipated by Connell.

The reference discloses a box for different items therein and includes thereon multiple pictorial representations of the different items and descriptive text for each item, all of which amounts to illustrations of performance characteristics of said items. Said representations and text inherently are capable of being used to differentiate between different golf balls, if packaged in said box. Mere differences in what is attributed to printed matter does not provide a basis on which patentability may be predicated. Ex parte Breslow, 192 USPQ 431, U.S. Industries, Inc et al v. Ladd, 141 USPQ376.

Claims 12-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Connell.

Golf balls with different playing characteristics, as disclosed by Taylor, usually are sold in boxes having a cover. It would be obvious to label said boxes with pictorial illustrations of each ball therein and descriptive text concerning features of each ball therein, since such is a conventional technique for informing the ultimate golfer buyer of the different golf balls available; as illustrated by Connell.

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No claim is allowed.

Any inquiry concerning this communication should be directed to Examiner Marlo at  
telephone number (703) 308-1148.

Marlo/tnt

December 14, 1998

*George J. Marlo*  
GEORGE J. MARLO  
PRIMARY EXAMINER  
ART UNIT ~~3711~~  
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